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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,771	11/29/2001	William E. Sloan	8863.77USU1	6612
30173	7590	06/03/2004	EXAMINER	
GENERAL MILLS, INC. P.O. BOX 1113 MINNEAPOLIS, MN 55440			HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER
			1722	
DATE MAILED: 06/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/997,771

Applicant(s)

SLOAN ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Applicants' election of Group I (claims 1-17) in response to the previous Office Action is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. See MPEP § 818.03(a).

2. The PTO-1449 forms submitted with Information Disclosure Statements (IDS) filed on March 12, 2002 and November 25, 2002 include listed U.S. patents where the given patent number does not correspond to the date or name for the patent (see the initialed copies of the 1449 forms provided with this Office Action). It has been assumed that the patent number is correct, and that rest of the information on the 1449 forms has been corrected. However, Applicants are advised to review the forms and submitted a new IDS if the patents intended to be cited were not correctly indicated.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (emphasis added). Thus, the term "same invention," in this

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context, means an invention drawn to identical subject matter.

See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-9 and 12-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending U.S. Pat. App. No. 10/433,537 (hereinafter "App. '537"). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-14 of App. '537 recite a baking pan identical to that recited in claims 1-9 and 12-14 of the instant application. Specifically, claim 1 of App. '537 recites the pan comprises (a) a first surface for receiving batter or dough thereon, the first surface having at least one receptacle for receiving batter or dough therein; (b) a stacking feature constructed and arranged to: (i) allow stacking of a first pan and a second pan when one of the first pan are rotated, and (ii) eliminate nesting of the

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first pan and the second pan when one of the first pan and the second pan are rotated; and (c) a wall extending from the first surface, the wall defining a pan perimeter having a height of at least 0.5 inch as is recited in claim 1 of the instant application. Claim 2 of App. '537 recites that the pan is made from a non-conductive material as is recited in claim 2 of the instant application. Claim 3 of App. '537 recites the height of the wall is about 0.5 inch to 2.5 inches, and claim 4 recites that height of the wall is about 1 inch to 2 inches as is recited in claim 3-4 of the instant application. Claim 5 of App. '537 recites that the non-conductive material is crystallized polyethylene terephthalate as is recited in claim 5 of the instant application. Claim 6 of App. '537 recites the pan is a muffin pan comprising a plurality of receptacles for receiving batter or dough therein as is recited in claim 6 of the instant application. Claim 7 of App. '537 recites that the plurality of receptacles are aligned in a first row and a second row, each row having at least two receptacles as is recited in claim 8 of the instant application. Claim 8 of App. '537 recites that the receptacles of the first row are aligned with the receptacles of the second row as recited in claim 9 of the instant application. Claim 9 recites the pan comprises twelve receptacles as is recited in claim 12 of the instant

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application. Claim 11 of App. '537 recites the pan to comprise six receptacles as is recited in claim 13 of the instant application. Claim 12 recites that an aperture defined by the first surface, the aperture being positioned between receptacles as is recited in claim 7 of the instant application. Claim 14 of App. '537 recites that the pan has a length of about 17 inches to 18 inches and a width of about 12 inches to 13 inches as is recited in claim 14 of the instant application.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of Hale (U.S. Pat. No. 3,197,058; previously of record).

In the Declaration of Matthew Lorence filed March 12, 2002, Applicants admit a pan is known comprising a first surface having a 12 receptacles for receiving the cooking material therein (Dec., ¶ 4). The known pan further comprises a wall extending above first surface about 1 inch (Dec., ¶ 4), and is made from crystallized polyethylene terephthalate (Dec., ¶ 6).

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Applicants' admitted prior art pan is not described as comprising a stacking feature to allow stacking (and thus, eliminate nesting) when the pans are rotated a certain direction.

Hale discloses a food tray. The tray comprises a plurality of receptacles that are directional as such to allow a plurality of trays to be nested when placed in one direction (fig. 4), and to be stacked when the trays are rotated in different directions (fig. 2). This allows the trays to be stored either without crunching items placed in the receptacles when stacked, or, alternatively, in a minimum space when the trays are nested (cl. 1, ll. 28-35).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the known pan as such to have the receptacles designed to allow for stacking when a plurality of trays are placed in one direction, and to allow nesting of the trays when rotated in another direction because such a configuration prevents crunching of items placed in the receptacles when the pan is stacked and would take up a minimum space when the pan nested as suggested by Hale.



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9. Claims 1-4, 6, and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (U.S. Pat. No. 3,191,796; previously of record).

Schwartz discloses a compartmented stacking and nesting container. The device comprises a first surface (10a) having multiple receptacles (12, 14, 16, and 18) therein. A stacking feature is constructed such as to allow stacking of a first container and a second container when one of the first and second container are rotated, and eliminate nesting of the first container and second container when one of the first and second containers are rotated (figs. 5-6; cl. 1, ll. 37-42; cl. 3, l. 74 - cl. 4, l. 49). The device also comprises a wall (10b) extending from the first surface, with the wall defining the perimeter of the device (fig. 1). Schwartz discloses a configuration shown as fig. 1 wherein a first row (14 & 16) are aligned with a second row (12 & 18) of receptacles.

Schwartz further discloses the container to be made from a flexible sheet material such as polyethylene or a gum plastic such as rubber-based styrene (cl. 2, ll. 56-58), which are non-conductive materials.

Claim 15 of the instant application recites that the pan comprises an "air distribution feature." The structure of the containers disclosed by Schwartz comprise an air distribution

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feature in that the containers are spaced from each other in the stacked position such that air can reach the containers (see fig. 6). Schwartz therefore anticipates claim 15.

Schwartz does not specify the height the wall extends above the first surface. However, as shown in figure 4, the size of the wall determines the distance between the containers in the stacking configuration- that is, the higher the wall, the more distance of separation between containers. Schwartz further notes that the fitting relationship between containers can be modified as desired (cl. 5, ll. 34-37). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the height of the wall disclosed by Schwartz to be in the range of about 1 inch to 2 inches because such a modification would merely change the fitting relationship between the containers. Note further, the determination of a cause-effective variable, such as in this case the height of the wall and the fitting relationship between the containers, is generally seen as being within the skill of one practicing the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Schwartz only shows the container as having four receptacles (12, 14, 16, and 18). However, Schwartz notes that

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the container can be modified to change the number of receptacles as such to have any number of receptacles (cl. 5, ll. 38-39). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the container disclosed by Schwartz as such to have six or twelve receptacles because as Schwartz notes, the number of receptacles can be modified to have any desired amount.

Claim 1 recites that claimed structure is a pan, and the receptacles are for receiving batter or dough therein, and claim 6 further recites the pan to be a muffin pan. These limitations are directed at the intended use of claimed apparatus. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, Schwartz discloses and suggests a container with all of the structural features claimed in the instant application described above. Further, Schwartz notes that the container is similar to those used for baking muffins (cl. 1, ll. 17-19). Thus, Schwartz discloses an apparatus which contains all of the features of the claimed apparatus and could

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be used in the claimed manner. Schwartz, therefore anticipates the uses recited in claims 1 & 6.

As further noted above, in fig. 1 Schwartz discloses a configuration wherein rows receptacles are aligned with one another. Schwartz further discloses a configuration in fig. 9 wherein the receptacles are not aligned with one another, noting specifically that the configuration is designed to be non-symmetrical (cl. 2, ll. 20-24 & cl. 5, ll. 3-21). Given the obviousness of changes the number of receptacles described above, it further would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the configuration shown in fig. 7 of Schwartz to have rows of receptacles, thus constituting a container with a row of receptacles misaligned with another row of receptacles because of Schwartz's suggestions on how the container can be beneficially modified.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz as applied to claims 1-4, 6, and 8-15 above, and further in view of Lau, Jr. et al (U.S. Pat. No. 3,638,827).

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Schwartz discloses the stacking and nesting container as described above. However, Schwartz does not disclose the container to comprise a lid attached thereto.

Lau, Jr. discloses a stackable and nestable container as well (see figs. 2 & 5). Lau, Jr. further discloses the container may be provided with a removable lid (43) for the purpose of closing the uppermost tray of a series of containers (see fig. 4 & cl. 4, ll. 36-42).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the container disclosed by Schwartz as such to further provide the container with a lid because this would allow for the closing of the upper most lid in a series of stacked containers as suggested by Lau, Jr.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of Kornely et al. (U.S. Pat. No. 4,508,768).

Applicants' admit that a prior art pan is known with features as described above. The prior art pan is not described to include a liner positioned between a first pan and a second pan.

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Kornely discloses a plurality of cooking pans which can be stacked (see figs. 2 & 6). Kornely further discloses a liner (10) to be placed between the pans when stacked for the purpose of protecting the inner surface of the pan (cl. 1, ll. 48-50).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have provided a liner between a set of the admitted prior art pans because such a liner would protect the inside surfaces of the known pans as suggested by Kornely.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroeter (U.S. Pat. No. 23,930) in view of Kornely et al.

Kroeter discloses a cooking pan comprising a first surface (1), the first having a plurality of receptacles (4) therein. A wall (2) extends from the first surface.

Kroeter does not disclose a liner to be positioned between a first and second pan.

Kornely discloses a plurality of cooking pans which can be stacked (see figs. 2 & 6). Kornely further discloses a liner (10) to be placed between the pans when stacked for the purpose of protecting the inner surface of the pan (cl. 1, ll. 48-50).

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It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have provided a liner between a set of stacked pans of the type disclosed by Kroeter because such a liner would protect the inside surfaces of the pans as suggested by Kornely.

Kroeter does not disclose the height that the wall extends from the first surface. However, as noted above in the rejection in view of Schwartz, the height of such a wall is a cause-effective variable in that such a height of the wall would determine, among other things, the distance between two of the pans disclosed by Kroeter when stacked. Further as noted above, the determination of a cause-effective variable, such as in this case the height, is generally seen as obvious to one of ordinary skill in the art. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the height of the wall to be at least 0.5 inch because this would adjust the variable to reach an optimum result such as the distance between the pans when stacked.

13. The following references not relied upon are cited as being related to the instant application:

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Ajmera (U.S. Pat. No. 4,522,301) discloses a stacking and nesting tray (see figs. 5 & 6).

Jackson (U.S. Des. Pat. No. 112,254) discloses a baking pan with a wall extending above the main surface (see figs. 1 & 3).

Krupa et al. (U.S. Des. Pat. No. 361,514) discloses a bread tray with a wall extending above the main surface (see fig. 1).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status



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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Donald Heckenberg  
May 18, 2004